

REMARKS

Claims 1, 2 and 7 are pending in this application. By this Amendment, claims 3-6 are cancelled and claim 1 is amended. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration since the amendments amplify issues previously discussed throughout prosecution; (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (d) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

Rejections Under 35 U.S.C. §103(a)

A. Iwamoto in view of Asano

The Office Action rejects claims 1-6 under 35 U.S.C. §103(a) over U.S. Patent No. 6,139,940 to Iwamoto et al. ("Iwamoto") in view of EP 0818322 A1 to Asano et al. ("Asano"). Claims 3-6 have been cancelled, thus rendering the rejection moot as to those claims. As to the remaining claims, Applicants respectfully traverse the rejection.

Claim 1 recites "[a] backprinting recording medium, comprising a transparent substrate, an ink-absorbing layer formed on the transparent substrate and a porous ink-permeable layer formed on the ink-absorbing layer and produced by dispersing a filler in a binding resin, wherein: the binder resin constituting the ink-permeable layer has a glass transition temperature of 10°C or higher, and a Shore D hardness at 25°C of 40 or higher, and

the binder resin constituting the ink-permeable layer is a polyester-based resin." Iwamoto and Asano do not teach or suggest such a backprinting recording medium.

The Office Action asserts that Iwamoto teaches an ink recording sheet including a substrate, an ink absorbing layer on the substrate and an ink permeable layer made of resin on the ink absorbing layer. The Office Action concedes that Iwamoto does not disclose a resin having a glass transition temperature of 10°C or higher. However, the Office Action asserts that Asano discloses an ink permeable layer including a resin having a glass transition temperature of 40°C or higher. Notwithstanding these assertions, Iwamoto and Asano do not teach or suggest a backprinting recording medium, comprising a transparent substrate, an ink-absorbing layer formed on the transparent substrate and a porous ink-permeable layer formed on the ink-absorbing layer.

The inkjet recording sheet of Iwamoto does not include an ink permeable layer. The Office Action refers to the Abstract of Iwamoto for its teaching of an ink permeable layer. However, the Abstract plainly states "the present invention comprises an ink absorbing layer on at least one surface of a substrate, and an ink impermeable layer comprising a hydrophobic resin on the surface of the ink absorbing layer" (emphasis added). Asano discloses an ink permeable gloss layer. A skilled artisan would not expect that an element of an ink permeable layer should be employed in an ink impermeable layer. As one of ordinary skill in the art would not have been motivated to combine the teachings of Iwamoto and Asano, a *prima facie* case of obviousness has not been made.

Claim 1 would not have been rendered obvious by Iwamoto and Asano. Claim 2 depends from claim 1, and thus also would not have been rendered obvious by the cited references. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

B. Hasegawa in view of Asano

The Office Action rejects claims 1, 2 and 5-7 under 35 U.S.C. §103(a) over U.S. Patent No. 5,027,131 to Hasegawa et al. ("Hasegawa") in view of Asano. Claims 5 and 6 have been cancelled, thus render the rejection moot as to those claims. As to the remaining claims, Applicants respectfully traverse the rejection.

Claim 1, incorporating the limitations of non-rejected claim 3, recites "[a] backprinting recording medium, comprising ... a porous ink-permeable layer ... produced by dispersing a filler in a binding resin ... wherein ... the binder resin constituting the ink-permeable layer is a polyester-based resin" (emphasis added). Neither Hasegawa nor Asano disclose a porous ink-permeable layer comprising a polyester-based resin. Accordingly, Hasegawa and Asano do not teach or suggest a backprinting recording medium as recited in claim 1.

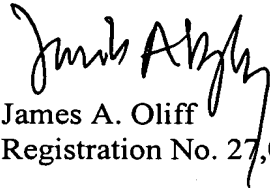
Claim 1 would not have been rendered obvious by Hasegawa and Asano. Claims 2 and 7 depend from claim 1, and thus also would not have been rendered obvious by the cited references. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 2 and 7 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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